



IFW 2192

Docket No.: R2184.0095/P095  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Hirotugu Satoh

Application No.: 09/783,553

Confirmation No.: 9369

Filed: February 15, 2001

Art Unit: 2192

For: OPTICAL RECORDING MEDIUM

Examiner: M. J. Yigdall

**REQUEST FOR RECONSIDERATION**  
**IN RESPONSE TO NON-FINAL OFFICE ACTION**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The application has been reviewed in light of the rejection dated March 7, 2007. Claims 1-5 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki (US 6,097,814) in view of Narin et al. (US 6,718,549), further in view of Tognazzini (US 6,600,713), and still further in view of Miller et al. (US 6,535,911). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. None of Mochizuki, Narin et al., Tognazzini, or

Miller et al., even when considered in combination, teach or suggest all limitations of independent claim 1.

Claim 1 recites an optical recording medium which stores, inter alia, “a storing program for causing updated software to be stored in a memory device of the computer and in the optical recording medium.” Applicant respectfully submits that none of Mochizuki, Narin et al., Tognazzini, or Miller et al. discloses, teaches, or suggests these limitations.

To the contrary, Tognazzini teaches that “[p]rogramming which instructs the CPU 400 to operate in accordance with the present invention as will be described in detail below may be stored in ROM or RAM.” Col. 5, ln. 24-26. Applicant respectfully submits that Tognazzini does not disclose, teach, or suggest a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium as recited in claim 1. Nor are Mochizuki, Narin et al., or Miller et al. cited for this limitation. Therefore, Mochizuki, Narin et al., and Miller et al. do not remedy the deficiencies of Tognazzini.

Furthermore, Applicant respectfully submits that there is no motivation to combine the cited references to obtain the invention of claims 1 and 4. In fact, Narin et al. teaches away from the motivation put forth in the Office Action for combination with Miller et al. Specifically, Narin et al. teaches that “[i]f the lightweight component 110 encounters any errors (e.g., the lightweight component is unable to connect to the server; the necessary registry entries are not found, etc.), the lightweight component 110 terminates itself without launching the core component 120.” Col. 7, ln. 64 – Col. 8, ln. 1 (emphasis added). This is contrary to the purported motivation in the Office Action (page 7) to combine Miller et al. with the other references to “provide the ability of resume any incomplete transmissions and ensure that all files are downloaded before

storing the updated software in the optical recording medium.” An objective reason for the combination can only be found in the specification of the present application, which is impermissible hindsight.

Moreover, the asserted motivation to combine Tognazzini with Narin et al. is not supported by the references. Although Narin et al. teaches that a computer 20 may have an optical drive 30 for use with an optical disk 31, Narin et al. teaches that software updates are to be loaded on the client computer 20, not on the disk 31. This is contrary to the purported motivation in the Office Action (page 7) to combine Tognazzini with the other references to “provide the ability to update a pre-recorded optical recording medium.” An objective reason for the combination can only be found in the specification of the present application, which is impermissible hindsight.

In addition, the “requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. . . .” *Eli Lilly & Co. v. Teva Pharms. USA, Inc.*, 2004 U.S. Dist. LEXIS 14724 at \*104; 2 *Chisum on Patents* § 5.04[1][e][vi]. In the present application, the lack of identifiable objective motivation to combine the four references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments.

The Office Action has done no more than cite four references, three of which allegedly provide only one element of the claimed invention, and allege that their combination renders the invention obvious. However, without the benefit of hindsight, there would have been no motivation to combine these references and the Office Action has failed to provide proof of any such motivation.

Motivation or suggestion to combine or modify prior art references “must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficos North America Corp.*, 299 F.3d 1313, 1334 (Fed. Cir. 2002). Because the “genius of invention is often a combination of known elements which in hindsight seems preordained,” the Federal Circuit requires a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). Yet there is no teaching or suggestion within any of the references that provide a motivation to combine them.

Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. See e.g., *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996); and MPEP §§ 706.02(j) and 2143 *et seq.* Furthermore, the “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP §706.02(j).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, a showing of an obvious combination requires more than just an amalgam of references, each of which providing one feature of the claimed invention.

Since Mochizuki, Narin et al., Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claim 1, claim 1 and dependent claim 4 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 1 and 4 be withdrawn.

Claims 2-3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mochizuki in view of Narin et al., further in view of Shaw (US 6,381,741), further in view of Tognazzini, and still further in view of Miller et al. This rejection is respectfully traversed.

Claims 2-3, and 5 recite limitations similar to claim 1; therefore, Shaw does not cure the above-discussed deficiencies of the Mochizuki, Narin et al., Tognazzini, and Miller et al. combination.

Moreover, Shaw, which has been cited for teaching “a software updating program,” teaches that “downloader code 24 is stored within permanent memory 14.” Col. 2, ln. 58-61 (emphasis added). Permanent memory 14 is a Read-Only Memory within the client computer 10. Col. 2, ln. 39-46. Applicant respectfully submits that Shaw does not disclose, teach, or suggest a software updating program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium as recited in claims 2-3 and 5. Thus, Shaw does not remedy the deficiencies of Mochizuki, Narin et al., Tognazzini, and Miller et al.

In addition, as discussed above, the lack of identifiable objective motivation to combine the five references, in addition to the sheer number of disparate references applied by the Office Action, is sufficient to overcome the asserted obviousness arguments.

Since Mochizuki, Narin et al., Shaw, Tognazzini, and Miller et al. do not teach or suggest all of the limitations of claims 2-3 and 5, claims 2-3 and 5 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 2-3 and 5 be withdrawn and the claims allowed.

In view of the above, Applicant believes the pending application is in condition for allowance.

Dated: June 5, 2007

Respectfully submitted,

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